

JKW AF

TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.
PJW190

In Re Application Of: Lee-Yin Chee, Kheng Guan (Nigel) Tan, Sie-Boo Chiang

| Application No. | Filing Date | Examiner | Customer No. | Group Art Unit | Confirmation No. |
|-----------------|---------------|-------------|--------------|----------------|------------------|
| 10/791,914 | March 3, 2004 | Kenan Cehic | 51389 | 2616 | |

Invention: METHOD OF GENERATING PACKETS WITHOUT REPETITION IN VERIFICATION OF A DEVICE

COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

August 28, 2008

The fee for filing this Appeal Brief is: \$510.00

- A check in the amount of the fee is enclosed.
- The Director has already been authorized to charge fees in this application to a Deposit Account.
- The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 01-0365 I have enclosed a duplicate copy of this sheet.
- Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.


Signature

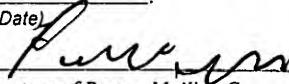
Dated: September 8, 2008

Paul J. Winters, Reg. No. 25,246

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on

September 8, 2008

(Date)


Signature of Person Mailing Correspondence

Paul J. Winters

Typed or Printed Name of Person Mailing Correspondence

CC:



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s): Lee-Yin Chee, Kheng Guan (Nigel) Tan, Sie-Boo Chiang

Assignee: Advanced Micro Devices, Inc.

Title: METHOD OF GENERATING PACKETS WITHOUT REPETITION IN VERIFICATION
OF A DEVICE

Serial No.: 10/791,914

Filed: March 3, 2004

Examiner: Kenan Cehic

Group Art Unit: 2616

Attorney Docket No.: PJW190

Mountain View, California
September 7, 2008

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

09/12/2008 CCHAU1 00000038 010365 10791914
01 FC:1402 510.00 DA

REAL PARTY IN INTEREST

The real party in interest is Advanced Micro Devices, Inc., the assignee of record.

RELATED APPEALS AND INTERFERENCES

None

STATUS OF CLAIMS

Claim 1 has been canceled.

Claims 2-6, all the claims remaining in this case, stand rejected. These claims are on appeal.

STATUS OF AMENDMENTS

All amendments have been entered.

SUMMARY OF CLAIMED SUBJECT MATTER

The invention of independent claim 2 (specification, page 2, lines 32-35, page 3, page 4, lines 1-12) is a method for use in verification of a device comprising providing a plurality of packet classes (10), providing a flag, which may be of a first or a second state, for each of the plurality of packet classes (10), and generating a packet (12); if the flag of the packet class of the generated packet is in the first state, testing the device (14, 16); if the flag of the packet class of the generated packet is in the first state, changing the flag of the packet class of the generated packet to the second state (14, 18).

The invention of independent claim 3 (specification, page 2, lines 32-35, page 3, page 4, lines 1-12) is a method for use in verification of a device comprising providing a plurality of packet classes (10), providing a flag, which may be of a first or a second state, for each of the plurality of packet classes (10), and generating a packet (12); if the flag of the packet class of the generated packet is in the first state, testing the device (14, 16); if the flag of the packet class of the generated packet is in the second state, not testing the device (14, 12).

The invention of independent claim 4 (specification, page 2, lines 32-35, page 3, page 4, lines 1-12) is a method for use in verification of a device comprising providing a plurality of packet classes (10), providing a flag, which may be of a first or a second state, for each of the plurality of packet classes (10), and generating a packet (12); if the flag of the packet class of the generated packet is in the second state, not testing the device (14, 12).

The invention of independent claim 5 (specification, page 2, lines 32-35, page 3, page 4, lines 1-12) is a method for use in verification of a device comprising (a) providing a plurality of packet classes (10), (b) providing an injection flag, which may be of a first or a second state, for each of the plurality of packet classes (10), and (c) generating a packet (12); (d) if the injection flag of the packet class of the generated packet is in the second state, not testing the device (14, 12); (e) if the injection flag of the packet class of the generated packet is in the first state, testing the device and setting the injection flag of the packet class of the generated packet to the second state (14, 16, 18).

GROUNDΣ OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 2 - 6 are patentable under 35 USC 103(a) over Takada et al., US Publication Number 2002/0089931, in view of Shipley, US Patent Number 5,633,742.

**REJECTION OF CLAIMS 2 - 6 UNDER 35 USC 103(a) OVER TAKADA ET AL, US
PUBLICATION NUMBER 2002/0089931, IN VIEW OF SHIPLEY, US PATENT
NUMBER 5,633,742.**

Claims 2 - 6

Initially, in regard to all claims 2 - 6, it is respectfully submitted that it would not be obvious to combine these documents as suggested by the Examiner.

The Examiner states with regard to Takada et al:

Takada is silent about:

For claim 2, a method for use in verification of a device, testing a device when transmitting a packet

For claim 3, 4 and 5 in method for use in verification of a device, testing a device when transmitting a packet and not testing the device when not transmitting a packet

Applicants agree. All of the setting and changes of values of flag fields in Takada et al. are related only to the control of the flow of data on the Internet (see for example paragraphs [0002]-[0009]). None of these settings or changes of flag field has anything to do with testing.

The Examiner goes on to state:

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Takada et al. by using the features, as taught by Shipley, in order to provide a monitoring system for communication devices that are battery powered (see columns 3-4).

The Examiner in particular refers to column 14, lines 25-35 of Shipley, quoted in full:

The transmitter 31 of the present invention is provided with a battery check circuit 181 which is utilized to monitor the battery 71 periodically to provide an advance warning that the battery will need replacement in the near future. The battery check circuit 181 includes the transistor Q7 and a Zener diode D1 of a

suitable type such as a LM385 connected in the manner shown. This battery check circuit 181 tests the battery voltage during every transmitted packet. If the battery voltage is at an acceptable level and a switch message is not being sent, a battery check message BOK is sent along with the normal transmitter identification confirming the battery condition.

The Examiner also refers to columns 3 and 4 of Shipley. Lines 35-41 of column 3 of Shipley are quoted in full:

In general it is an object of the present invention to provide an optical data communication and location apparatus, system and method and transmitters and receivers for use therewith which provides continuous real time information on the location of people, equipment, files and other mobile objects in a facility.

As will be noted, the type of device described in Shipley is quite limited in its scope of operation, and consequently lends itself to battery power. The Internet as discussed in Takada et al. is not a monitoring system and is not, nor would it be, battery powered.

The Examiner further states:

So system method of Takada could be implemented on such a general wireless transmitter, where it would be beneficial to provide battery saving features, so that the user of the system can use the device longer (see Shipley col 4).

The statement of the Examiner that something “could be implemented” is not the appropriate test. As is well understood, the Examiner must provide an apparent reason to combine the known elements in the fashion claimed and must articulate this reasoning with a rational underpinning to support a conclusion of obviousness. As stated in *KSR International Co. v. Teleflex, Inc.* (U.S. Supreme Court), 550 U.S. ____ (2007):

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent

reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Applicants submit that the Examiner has not done this. Indeed, applicants submit that not only is there no apparent reason to combine the known elements of Takada et al. and Shipley, such a change would not be undertaken as it would be impractical. The fact that it would be impractical to bodily incorporate features of a secondary reference into the structure of a primary reference is strong evidence that the combination would not be obvious.

It is therefore respectfully submitted that it would not be obvious to combine the disclosures as suggested by the Examiner, and that claims 2-6 should be allowed on this basis.

In regard to claims 3, 4, 5 and 6, each of these claims includes the limitation of not testing the device if the flag of the packet class is in the second state. The Examiner agrees that Takada et al. do not disclose testing a device when transmitting a packet and not testing the device when not transmitting a packet (see above quoted Examiner’s comments). With regard to Shipley, the Examiner states:

For claim 3 and 4, Shipley discloses a method for use in verification (see col 14 25-35 “tests the battery voltage”) of a device (see fig. 9, 31), testing a device (see col 14 25-35 “tests the battery voltage”) when transmitting a packet (see col 14 25-35 “tests the batteries voltage... transmitted packet”) and not testing the device (see col 14 25-35 “tests the batteries voltage... transmitted packet”) when not transmitting a packet (see col 14 25-35 “tests the batteries voltage... transmitted packet”)

In Shipley, every packet is transmitted (the device of Shipley is a transmitter, see description of operation thereof in Shipley Abstract and Specification), and as set forth in the portion of Shipley quoted above (column 14, lines 25-35, relied on by the Examiner on the point of “not testing the device when not transmitting a packet”), the battery check tests the battery voltage during every transmitted packet. There is no situation where a packet is transmitted and

the battery is not tested. Thus, even if the references were combined as suggested by the Examiner, there is no disclosure of not testing the device if a flag of the packet class of the generated packet is in a second state (claims 3, 4, 5 and 6). It is therefore respectfully submitted that even if the references were combined as suggested by the Examiner, this limitation would not be met, i.e. the resulting method would not anticipate applicants' claim 3-6.

The Examiner states:

Applicant further argues that there is "no disclosure of not testing the device for a transmitted device". In response to applicant's argument that the references failed to show certain features of applicants invention, it is noted that the features upon which applicant relies (i.e., "no disclosure of not testing the device for a transmitted device") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988b F2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

This statement clearly is in error.

Claim 3 recites:

if the flag of the packet class of the generated packet is in the second state, not testing the device.

Claim 4 recites:

if the flag of the packet class of the generated packet is in the second state, not testing the device.

Claim 5 recites:

(d) if the injection flag of the packet class of the generated packet is in the second state, not testing the device;

Claim 6 recites:

The method of claim 5 and further comprising repeating steps (c) through (e) thereof.

It is therefore respectfully submitted that claims 2-6 should be allowed.

CLAIMS APPENDIX

2. A method for use in verification of a device comprising:

providing a plurality of packet classes;

providing a flag, which may be of a first or a second state, for each of the plurality of packet classes;

generating a packet;

if the flag of the packet class of the generated packet is in the first state, testing the device;

if the flag of the packet class of the generated packet is in the first state, changing the flag of the packet class of the generated packet to the second state.

3. A method for use in verification of a device comprising:

providing a plurality of packet classes;

providing a flag, which may be of a first or a second state, for each of the plurality of packet classes;

generating a packet;

if the flag of the packet class of the generated packet is in the first state, testing the device;

if the flag of the packet class of the generated packet is in the second state, not testing the device.

4. A method for use in verification of a device comprising:
 - providing a plurality of packet classes;
 - providing a flag, which may be of a first or a second state, for each of the plurality of packet classes;
 - generating a packet;
 - if the flag of the packet class of the generated packet is in the second state, not testing the device.

5. A method for use in verification of a device comprising:
 - (a) providing a plurality of packet classes;
 - (b) providing an injection flag, which may be of a first or a second state, for each of the plurality of packet classes;
 - (c) generating a packet;
 - (d) if the injection flag of the packet class of the generated packet is in the second state, not testing the device;
 - (e) if the injection flag of the packet class of the generated packet is in the first state, testing the device and setting the injection flag of the packet class of the generated packet to the second state.

6. The method of claim 5 and further comprising repeating steps (c) through (e) thereof.

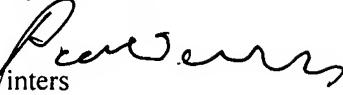
EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS

None.

Respectfully submitted,


Paul J. Winters
Reg. No. 25,246
Attorney for Applicant(s)

I certify that this document is being deposited on September 8, 2008 with the U.S. Postal Service as first class mail under 37 C.F.R. §1.8 addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Signature 

Paul J. Winters
Typed or printed name